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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
TOPGYAL, GELEK W	

ART UNIT	PAPER NUMBER
2621	

DATE MAILED: 04/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/982,291	OKAMOTO ET AL.	
	Examiner	Art Unit	
	Gelek Topgyal	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 October 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-54* is/are pending in the application.

4a) Of the above claim(s) *1-15, 30-40,43-49* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *16-29,41,42,50-54* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *19 October 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 1-15, 30-40, and 43-49 are drawn to a recording and reproducing apparatus that possesses the feature of "retention period and playback permission period", classified in class 386, subclass 46.

   II. Claims 16-29, 41-42, and 50-54 are drawn to a recording and reproducing apparatus that possesses the feature of "copy permission period", classified in class 386, subclass 94.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions as disclosed above in Group I regarding "retention period and playback permission period" and Group II regarding "copy permission period" are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination that teaches the feature of "retention period and playback permission period" as recited in claims 1-15, 30-40, and 43-49 of Group I, has separate utility such as the feature of "copy permission period", as recited in claims 16-29, 41, 42, and 50-54 of Group II. See MPEP § 806.05(d).

3. Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Melvin Kraus on March 31, 2006 a provisional election was made with traverse to prosecute the invention of Group II, claims 16-29, 41-42, and 50-54. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-15, 30-40, and 43-49 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 16-19, and 41, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroda (US 6,707,774) in view of Agnihotri (US 6,771,885).

Regarding claim 16, Kuroda teaches a digital information recording apparatus comprising a recording circuit for recording information of a copy permission period included in said digital information and indicating a period for permitting said digital

information recorded on said first recording medium to be copied (See col. 5, lines 61-col. 6, lines 58, Kuroda teaches a recording apparatus that allows a user to record broadcast television programs.) and recorded only once from said first recording medium onto a second recording medium different from said first recording medium after recording of said digital information on said first recording medium (See col. 7, lines 38 - col. 9 line 32, Kuroda teaches that copy protection information in the form of CGMS only allows a program to be copied once from first medium to another medium.) But Kuroda fails to particularly specify in his system of the capability of the apparatus to perform programmed or preset recording. Programmed recording is interpreted to be the period of time that the copying can take place.

In an analogous art, Agnihotri teaches the ability for the user to program the recording apparatus to perform recording of a video program for a certain defined period of time. The copy permission period is therefore interpreted to be the period of time that the recording apparatus is able to perform the recording, which is the preset recording stored in memory (16) of the recording apparatus (10) (See col. 2, lines 20-28 and Fig.1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the programmable recording ability of Agnihotri into the recording apparatus of Kuroda to allow for more convenience and unattended recording on part of the user.

Reproducing claim 17 is rejected for the same reasons as discussed in recording claim 16 above, and furthermore Kuroda teaches a CGMS detector to detect the

copyright information (Fig. 6, element 16) and Agnihotri teaches that the processor is capable of controlling the recording of a programmed recording (col.3, lines 23-30, and Fig. 1, element 15).

Regarding claim 18, the combination of Kuroda and Agnihotri teaches the limitations as set forth under claim 17 above. Furthermore, Agnihotri teaches that the recording will take place for the duration that the scheduled video program is aired, and therefore, when the scheduled video program has finished, the recording will terminate (col. 2, lines 20-48.)

Regarding claim 19, the combination of Kuroda and Agnihotri teaches the limitations as set forth under claim 17 above. Furthermore, it is inherent that a user can personally operate the remote control to achieve continued recording after the recording period is over.

The transmitting claim 41 is rejected for the same reproducing claim 17 as discussed above, and furthermore, Kuroda teaches that when the video information is copied to the second medium, the video program has been transferred by the reproducing apparatus 50 to the recording apparatus 10 (Fig. 1, elements 10, and 50).

8. Claims 20-25 , 42, and 50, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroda (US 6,707,774) in view of Agnihotri (US 6,771,885), and further in view of Ichimura (US 6,034,832).

Regarding claim 20, Kuroda teaches a digital information recording apparatus comprising a recording circuit for recording information of move permission included in said digital information and permitting, even when said digital information is recorded on said first recording medium and thereafter inhibited from being copied and recorded onto a second recording medium different from said first recording medium (See col. 5, lines 61-col. 6, lines 58, Kuroda teaches a recording apparatus that allows a user to record scheduled video programs from one media to another. Kuroda also teaches a copy protection code in the form of watermark in the digital video signal that allows the system to apply copyright protection, See col. 7, lines 54 – col. 9, line 52). But Kuroda fails to particularly specify in his system of the capability of the apparatus to perform programmed or preset recording. Programmed recording is interpreted to be the period of time that the copying can take place. Kuroda also fails to teach that the video program from the first medium is at least partly disabled for reproduction.

In an analogous art, Agnihotri teaches the ability for the user to program the recording apparatus to perform recording of a video program for a certain defined period of time. The copy permission period is therefore interpreted to be the period of time that the recording apparatus is able to perform the recording, which is the preset recording stored in memory (16) of the recording apparatus (10) (See col. 2, lines 20-28 and Fig.1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the programmable recording ability of Agnihotri into

the recording apparatus of Kuroda to allow for more convenience and unattended recording on part of the user.

Furthermore, the combination of Kuroda and Agnihotri fails to teach that at least a part the video program on the first medium is disabled for reproduction.

In an analogous art, Ichimura teaches that when video program is reproduced and copied from a first medium, renewed copy protection information is rewritten on the first medium and thereby, and, in the case that no more copies are allowed, the first medium is inhibited from reproduction. (col. 15, line 50 – col. 16, line 58).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the ability to at least disable a part of the video program as taught by Ichimura into Kuroda and Agnihotri's system to allow strict copy protection execution on the first copy of the recorded copyright information.

Regarding claim 21, the combination of Kuroda, Agnihotri and Ichimura teaches the limitations as set forth under claim 20 above. Furthermore, Kuroda teaches that a count for the number of copies is part of the watermark information. (see col. 7, line 55 – col. 9, line 32).

The reproducing claim 22 is rejected for the same reasons are discussed in recording claim 20 and 21, above. Furthermore, Kuroda teaches a watermark detector to detect the copyright information (Fig. 6, element 18), and Agnihotri teaches that the processor is capable of controlling the recording of a programmed recording (col.3, lines 23-30, and Fig. 1, element 15), and Ichimura teaches a controller (Fig. 1, element 11) that does the task of disabling the video program on the first medium from reproduction.

Claim 23 is rejected for the same reason as stated in claims 17 and 20 above. Claim 23 combines the limitations of claim 20 into the limitations of claim 17, and is therefore rejected for the same reason as stated.

Regarding claim 24, the combination of Kuroda, Agnihotri and Ichimura teaches the limitations as set forth under claim 22 above. Furthermore, Kuroda teaches that when the video program has been copied onto to the second medium, the count is decremented (col. 7, line 38 – col. 9, line 32).

Regarding claim 25, the combination of Kuroda, Agnihotri and Ichimura teaches the limitations as set forth under claim 22 above. Furthermore, Kuroda teaches that when the move is made from the first medium to the second medium, the count is written to zero, but fails to teach that the count is rewritten in the copy protection information in the first medium (col. 7, line 38 – col. 9, line 32).

Ichimura teaches that when a copy is made, the copy protection information in the video program on the first medium is rewritten.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate copy protection information on the first medium to be rewritten as taught by Ichimura into Kuroda's decrement counting system to allow for strict copy protection implementation, even on the first copy of the video program.

The transmitting claim 42 is rejected for the same reasons as stated above in reproducing claim 22, and furthermore, Kuroda teaches that when the video information is copied to the second medium, the video program has been transferred by the reproducing apparatus 50 to the recording apparatus 10 (Fig. 1, elements 10, and 50).

Claim 50 is rejected for the same reasons as stated in claim 22 above. The processing of delivering and moving video program from a first medium to a second medium are equivalent.

9. Claims 26-29, and 51-54, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroda, in view of Agnihotri, further in view of Ichimura, and further in view of Kuno (6,584,552).

Regarding claims 26-29, the combination of Kuroda, Agnihotri and Ichimura teaches the limitations as set forth under claim 22 above, but they fail to teach that the device erases encrypted information set in blocks.

In an analogous art, Kuno teaches a recording and reproducing apparatus that teaches that when the video program is being reproduced, the encrypted audio and video data are placed in blocks, and when the reproduction has completed for a particular block, the block is deleted (col. 61, line 58 – col. 66, line 24.)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the deletion of encrypted audio and video data after it is being reproduced as taught by Kuno into the disabling circuit as taught by the combination of Kuroda, Agnihotri and Ichimura, to implement strict and effective copy right protection.

Claim 51 is rejected for the same reasons as stated in claim 26 above. When the video program, after being formed into blocks, are erased, it is disabled from being reproduced.

Claim 52 and 53 are rejected for the same reasons as stated above in claims 27 and 28, respectively.

Claim 54 is rejected for the same reasons as stated above in claim 29, and furthermore Kuno discloses that the information in the blocks are deleted after being played back on the account that the reproduction is interrupted. Therefore the reproduction can be interrupted at any moment, including any time less than 1 minute.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The cited references are related to apparatuses that implement copyright protection on copy protected video programs.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gelek Topgyal whose telephone number is 571-272-8891. The examiner can normally be reached on 8:30am -5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gelek Topgyal
4/13/2006